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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/977,774	10/15/2001	Hal Pringle	DKT 01096 (BWI-00073)	3759

7590 01/06/2004

BORGWARNER INC. PATENT DEPARTMENT  
POWER TRAIN TECHNICAL CENTER  
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AUBURN HILLS, MI 48326

EXAMINER

MCANULTY, TIMOTHY P

ART UNIT	PAPER NUMBER
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3682

DATE MAILED: 01/06/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/977,774

Applicant(s)

PRINGLE ET AL.

Examiner

Timothy P McNulty

Art Unit

3682

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 28 November 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-9 and 11-22 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-9 and 11-22 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 13 June 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
- a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_ 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### *Drawings*

1. The proposed corrected drawing of figure 1 received on 13 June 2003 is approved.

### *Claim Rejections - 35 USC § 103*

2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
3. Claims 1-9 and 11-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent No. 5,544,540 to Holman (Holman '540) in view of US Patent No. 3,135,213 to Smith et al. (Smith).

Holman '540 discloses in figure 3, a fluid pump mounted within a transmission reservoir comprising a pump housing; a pump element; a pumping chamber having an intake port and an exit port; at least one other intake port 61 or exit port 62 derived from porting configured in a surface adjacent to and not integral with the pump; but does not disclose said pump element operatively connected to an electric motor. However, Smith teaches in the Figure a submersible motor pump comprising among other things a pump element operatively connected to an electric motor. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the apparatus of Holman '540 in view of the teachings of Smith to connect said pump element to an electric motor so as to eliminate the need to connect said pump element to a driven shaft or gear of the transmission and provide operation of said pump when said transmission is not operated.

***Response to Arguments***

4. Applicant's arguments with respect to claims 1-9 and 11-22 have been considered but are moot in view of the new ground(s) of rejection. Although the applicant asserts that neither the reference combination of Zepp et al. in view of Ford, Jr., et al. nor the reference combination of Fischer et al. in view of Ford, Jr., et al. discloses the claimed apparatus. However, the reference combination of Holman '540 in view of Smith does disclose the claimed apparatus.

Additionally, the examiner recognizes that references cannot be arbitrarily combined and that there must be some reason why one skilled in the art would be motivated to make the proposed combination of primary and secondary references. *In re Nomiya*, 184 USPQ 607 (CCPA 1975). However, there is no requirement that a motivation to make the modification be expressly articulated. The test for combining references is what the combination of the disclosures taken as a whole would suggest to one of ordinary skill in the art. *In re Simon*, 174 USPQ (CCPA 1972); *In re McLaughlin*, 170 USPQ 209 (CCPA 1971). References are evaluated by what they suggest to one versed in the art, rather than by their specific disclosures. *In re Bozek*, 163 USPQ 545 (CCPA 1969).

Furthermore, the term integral may be construed relatively broad, *In re Dike* 157 USPQ 581 (CCPA), and integral is not narrowly limited to two elements being structurally integral but includes elements that are rigidly secured to be "integral in a functional sense." *In re Clark* 102 USPQ 241 (CCPA). As such, the present invention, as currently claimed, includes the limitation that the porting surface is configured to be "not formed integrally with the pump" which can be construed to include structures that are either structurally integral or functionally integral. Finally, the preferred embodiment of the present invention depicts the pump rigidly secured to the porting surface, thus the pump is functionally integral with the porting surface.

• Art Unit: 3682

*Conclusion*

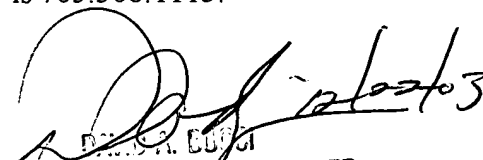
5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Timothy P McAnulty whose telephone number is 703.308.8684. The examiner can normally be reached on Monday-Friday (7:30-5:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Bucci can be reached on 703.308.3668. The fax phone number for the organization where this application or proceeding is assigned is 703.872.9326.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703.308.1113.

tpm

20 December 2003

  
DAVID A. BUCCI  
SUPERVISOR  
TECHNOLOGY CENTER 3600